

REMARKS

Claims 1-4, 10, 12-17 and 28-37 are pending in this application. Claims 1, 2, 10, 13, 14, 15, and 16 are amended. Claims 5-9, 11 and 18-27 are canceled.

***Claim Rejections – 35 USC §112***

The rejection of claims 1-4, 13-16 and 28-32 under 35 USC §112 is respectfully traversed.

With respect to claim 1, to the extent the rejection is understood, the preamble has been amended to recite that the protector has a surface that has a concave curved contour and an opposite surface that has a convex curved contour. To the extent that the rejection requires the recitation of any additional structure, MPEP §2173.02 provides:

“In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) (The preamble of the *Larsen* claim recited only a hanger and a loop but the body of the claim positively recited a linear member. The court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112 paragraph 2.). See also *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*,

370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004) ('The requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles...Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.')."

Reading claim 1 in its entirety, it is unclear what additional structure the Examiner views as being necessary to render the meaning of the claim discernible.

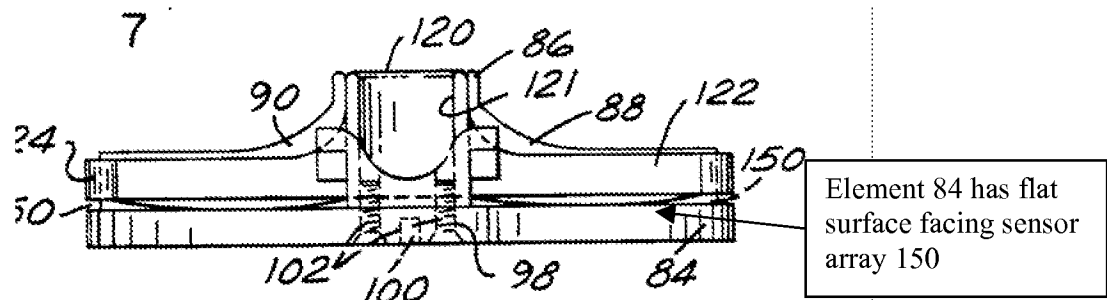
Regarding claim 2, the words "of the protector" have been added after the words "the first portion." To the extent that the rejection of claim 2 is understood, this amendment is believed to overcome the rejection. Claim 16 has been similarly amended, and the rejection is believed to be overcome.

With respect to claims 13-15, these claims have been amended to recite complementary mounting members instead of mating positioning members. This amendment is believed to overcome the rejection.

***Claim Rejections – 35 USC §102(b)***

Applicants respectfully traverse the rejection of claims 1, 3-4, 10, 12-15 and 17 under 35 USC 102(b) as being anticipated by (5,470,354) Hershberger et al.

In Hershberger et al., the sensor array is positioned on a *flat surface* of element 84; the sensor array is not positioned between two curved contoured surfaces. In the first embodiment of Hershberger et al., the sensor component 150 is disclosed as being located on the planar upper surface 92 of the base member 84 of the tibial component. (See Col. 6, lines 53-60). This location is illustrated in FIGS. 5 and 7. Surface 92 of element 84 of Hershberger et al. is described as being "planar" and "flat and smooth" to provide a satisfactory surface for the force transducer to contact (col. 6, lines 57-66).



Thus, if element 84 is considered to comprise a joint trial, it does not have an articulating surface that has a curved contour that is curved in a plurality of intersecting cross-sections and that is shaped to receive the articulating surface of a second joint trial. (Comparing FIGS. 3 and 5-7 of Hershberger et al. element 84 has edges that are curved in a single plane, as shown in FIG. 3.) Absent this element, Hershberger et al. does not anticipate claim 1.

In the Response to Arguments section of the Office Action, the Examiner appears to have taken the position that the preamble of claim 1 does not comprise a limitation and does not impact claim construction. However, claim 1 is written in the form set forth in 37 CFR §1.75(e)<sup>1</sup>. As set forth in MPEP §608.01(m): "The preamble of this form of claim is considered to positively recite and clearly include all of the elements or steps recited therein as part of the claimed combination."<sup>2</sup> The preamble of claim 1 relates to the invention of Ray C. Wasielewski described in U.S. Pat. App. Ser. No. 10/667,763, entitled "Apparatus,

<sup>1</sup>"(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order: (1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) A phrase such as "wherein the improvement comprises," and (3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion."

<sup>2</sup> See also *Epcon Gas Sys. Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022, 61 U.S.P.Q.2D 1470 (Fed. Cir. 2002) ("Jepson form allows a patentee to use the preamble to recite elements or steps of the claimed invention which are conventional or known." [citation omitted] However, in *Rowe v. Dror*, this court stated that "when this form is employed, the claim preamble defines not only the context of the claimed invention, but also its scope." [citation omitted]. According to *Rowe* and *Kegel*, the fact that the patentee has chosen the Jepson form of the claim evidences the intention "to use the preamble to define, in part, the structural elements of his claimed invention." *Id.*; [citation omitted] Thus, the preamble is a limitation in a Jepson-type claim. [citations omitted]"

System and Method for Intraoperative Performance Analysis During Joint Arthroplasty<sup>3</sup>,” assigned to the assignee of the present application.

Accordingly, claim 1 and its dependent claims 3-4 are patentable over Hershberger et al.

With respect to independent claim 10, in Hershberger et al. the surface of the sensor/transducer 150 of FIG. 3 that contacts the element above it is flat: the sensor/transducer 150 is not shaped to define a contour that is curved in a plurality of intersecting cross-sections. As discussed above with respect to claim 1, the preamble of claim 10 is part of the claimed combination. Accordingly, claim 10 is patentable over Hershberger et al.

In the “Response to Arguments” section of the Office Action, the following statement is made:

“...Applicants’ claim recites the limitation ‘a stud extending between the protector and the surface adjacent the curved concave articulating surface of the first joint trial.’ Hershberger clearly discloses this limitation (Fig. 7).”

However, as discussed above, if element 84 is considered to comprise the joint trial, its upper surface is flat and planar. The curved edge of Hershberger et al. element 84 (see FIG. 3) cannot be considered to comprise an articulating surface – nothing articulates against it. Thus, if element 84 of Hershberger et al. is considered to be a trial, there is no curved concave articulating surface and element 102 cannot be said to be adjacent to a curved concave articulating surface of a joint trial.

With respect to independent claim 12 and its dependent claims 13-15 and 17, in Hershberger et al., if element 86 is considered to comprise a protector, it does not appear to

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<sup>3</sup> U.S. Pat. App. Ser. No. 10/667,763 was rejected on 11-26-2007. A response was filed 4-23-2008.

have two curved contoured surfaces that are curved in a plurality of cross-sections and a thickness between such surfaces that is less than half the thickness of the joint trial at the articulating surface. Accordingly, claim 12 and its dependent claims are patentable over Hershberger et al.

***Claim Rejections – 35 USC §103***

The rejection of claims 28-37 under 35 USC §103 as being unpatentable over Hershberger et al. is respectfully traversed.

In the Office Action, the rejection of claims 28-37 is based upon the view that:

**It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided concave and/or convex articulating surfaces on the trial to ensure slidable rotatable contact between the trial and the protector.**

However, Hershberger et al. teaches use of a flat surface against the sensor/transducer and a curved surface bearing against the flat surface of the sensor/transducer: “The surfaces are flat and smooth in order to provide a satisfactory surface for the force transducer to contact.” (col. 6, lines 59-60). Thus, if element 84 is considered to comprise a trial in Hershberger et al., Hershberger et al. teaches providing a flat surface on that trial. And where Hershberger et al. illustrate a curved rocker member on the base (see FIGS. 31 and 32, col. 8, lines 15-19 and col. 11, lines 22-25), the opposite member is flat and smooth. Accordingly, claims 28-37 are patentable over Hershberger et al.

***Conclusion***

It is believed that the claims 1-4, 10, 12-17 and 28-37 are in condition for allowance. Applicants respectfully request further examination and reconsideration. Applicants further respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,  
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